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| 38779 7590 08/13/2008 SENNIGER POWERS LLP (MSFI) ONE METROPOLITAN SQUARE, 16TH FLOOR ST. LOUIS, MO 63102 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/774,995

Applicant(s)

GOODMAN, JOSHUA

Examiner

KEVIN S. MAI

Art Unit

2152

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-17 and 19-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-17 and 19-40 is/are rejected.
- 7) ☒ Claim(s) 11 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action has been issued in response to Applicant's Request for Continued Examination filed July 18, 2008.
2. Claims 1, 11, 12, 23, 24, 29 and 36 have been amended. Claim 18 has been canceled. Claims 1, 2, 4-17 and 19-40 are pending in the application.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 18, 2008 has been entered.

Claim Objections

4. Claims 11 and 23 are objected to because of the following informalities: Claims 11 and 23 were amended to provide a step, however they are still written in a manner that is confusing. If they were rewritten to recite something similar to this "the method of claim 1, further comprising executing computer-executable instructions, stored on one or more computer-storage media, to implement said receiving, said identifying, said storing said sending the communication and said sending information" they would be clearer. As they stand right now it appears that they are still primarily claiming the computer storage media, in the example it

instead focuses on the execution of the steps via computer-executable instructions, which is seen to be more like a step in the method claim.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 12, 24, 29 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant states that paragraph [0042] provides the support for the amendments in claims 1, 12, 24, 29 and 36, however examiner is unable to find the specific areas that support "information indicating the type of the incoming communication from the recipient" and "information indicating whether the time between the last time of the incoming communication the present time does not exceed the predetermine time limit". The closest mention of this examiner found in paragraph [0042] was 'software instructions of server 202 are adapted to include in communication 226 the date and time of the last incoming communication of recipient 206'. If there is another paragraph that provides support for these limitations it is requested that the applicant point them out to the examiner.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 12, 24, 29 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 12, 24, 29 and 36 were amended to recite "sending information to the recipient, said information indicating at least one of the following: the stored data indicating the last time that the incoming communication from the recipient is received, the type of the incoming communication from the recipient, and whether the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit such that the recipient can confirm the preexisting business relationship between recipient and sender defined under the anti-spam rules, laws and regulations". However, if the information sent includes whether the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit, it is seen that the information would be sent even if the present time did exceed the predetermined time limit. That piece of information can either convey that either the predetermined time limit has been exceeded or has not been exceeded, and thus if that piece of information can be included it is seen that a message that has exceeded the time limit would be sent to the recipient. This information sent would then not be in compliance with the anti-spam rules, laws and regulations. It is likely that the applicant intended to claim something along the lines of "information indicating that the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit". Namely this piece of information would only confirm that the message was being sent out legitimately. The "whether" used in the claim language suggests either scenario and as such causes the undesirable situation to occur.

9. In view of claim 18 being canceled, the pending claim rejection under 35 USC § 112 has been withdrawn.

Response to Arguments

10. Applicant's arguments filed July 18, 2008 have been fully considered.

11. Applicant argues that Griebenow fails to disclose "sending information to the recipient, said information indicating at least one of the following: the stored data indicating the last time that the incoming communication from the recipient is received, the type of the incoming communication from the recipient, and whether the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit such that the recipient can confirm the preexisting business relationship between recipient and sender defined under the anti-spam rules, laws and regulations". The arguments have been considered but are not persuasive.

Applicant suggests that the amended claims would not be obvious in light of the combined references; however examiner asserts that the previous rationale used to combine still supports the scenario where the stored data indicates the last time the incoming communication from the recipient is received. Griebenow explains in column 8 lines 30 – 50 that renewals are sent if a consumers subscription is about to lapse, this is done to prevent the termination of the subscription. Similarly, contact would be made to the consumer in Fergusson's invention to encourage a response such that future communications would remain DNC complaint, and thus

prevent the termination of their business relationship. Thus it is seen that combining Griebenow would have been obvious because it provides a convenient way to prevent the termination of a business relationship. As to the other two pieces of information being non-obvious (the type of communication and whether the information exceeds the predetermined time limit), it is seen that the claim only recites at least one of, and Griebenow is obvious in view of at least one of the three pieces of information.

Applicant further suggests that Griebenow teaches a situation where renewal notices are sent after the subscription has ended, which would not be in compliance with the anti-spam rules, laws and regulations. This is not seen to be relevant because Griebenow still discloses the limitation of sending information to the recipient including at least one of the following: the last time that the incoming communication was received, the type of communication, and whether the predetermined time limit has been exceeded. Furthermore, based on the steps taken in Griebenow, it is seen that Griebenow never actually would send a renewal notice at an inappropriate time since renewal notices are always sent immediately after a publication is delivered. Since a relationship still exists while the subscription is being sent, and the renewal notice is always sent right after publications are delivered, it is seen that the renewal notice would always be sent within the time frame of the subscription.

12. Applicant argues that "it would be in the sender's best interest not to show to the recipient whether the predetermined time limit has or has not been exceeded". However after this, applicant suggests that renewal notices sent after the subscription has ended would not be in compliance with the anti-spam rules, laws and regulations. Since the amended subject matter

would apparently show the recipient whether the predetermined time limit **has** or has not **been exceeded** (emphasis added) it is seen that these communications would also fall under the category of not being in compliance. As such it is seen that the two arguments contradict each other.

13. Other arguments toward claims 2, 4-17 and 19-40 deal with the issues addressed above and thus for similar reasons those claims remain not allowable.

Claim Rejections - 35 USC § 103

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15. Claims 1, 2, 4-11, 24-33 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable U.S. Pub. No. 2003/0212566 A1 to Fergusson et al. (hereinafter “Fergusson”) and further in view of U.S. Pub. No. 2004/0122730 A1 to Tucciarone et al. (hereinafter “Tucciarone”) and U.S. Pat. No. 5850520 to Griebenow et al. (hereinafter “Griebenow”).

16. **As to Claim 1**, Fergusson discloses **a method for a sender of communications to comply with a predetermined time limit** (Paragraphs [0011] – [0013] of Fergusson disclose determining if a valid prior existing relationship exists with a client by checking if a client has transacted business with the organization within the past year), **comprising:**
Fergusson does not explicitly disclose **receiving an incoming communication from a recipient of communications, said received incoming communication including at least one of the**

following types: an electronic mail (e-mail) message, a post mail, an instant messaging message, a chat message, and a website access;

However, Tucciarone discloses this (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication). It is seen that the incoming communication includes at least an e-mail message and a website access based on figure 4 and paragraph [0012] of Tucciarone).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of complying with a predetermined time limit as disclosed by Fergusson with receiving incoming communications from the recipient as disclosed by Tucciarone. One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to provide a method of opt-in for the consumers. Tucciarone explains in paragraph [0005] that opt-in email is largely used to generate leads, increase sales, retain, up-sell and cross-sell customers. Thus since opt-in is disclosed to be beneficial to a business it would have been obvious to combine it with Fergusson to further aide the business. Fergusson discloses **identifying a location of the recipient based on the received incoming communications** (Paragraph [0015] of Fergusson discloses doing a reverse phone number lookup to find the home address of the DNC client); **storing data indicating a last time that the incoming communication is received by the sender based on the received incoming communication** (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business

with the organization. Since the system is mining a database for the information it inherently implies that at the time of original transaction the last time a communication was received was stored in a database);

sending a communication to the recipient if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed a predetermined time limit, said predetermined time limit being defined and prescribed by anti-spam rules, laws and regulations of the identified location of the recipient for establishing a preexisting relation between the recipient and the sender

(Paragraphs [0011] – [0013] of Fergusson disclose that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit). As to the time of prior relationship being defined by anti-spam rules, paragraph [0013] of Fergusson discloses because the definition of when a prior or existing relationship exists may differ depending on the state, different parameter values may be set for each of the state DNC listings. Thus it is seen that since the time parameter is changed from state to state, that the time parameter is defined according to each individuals states DNC laws, which are for establishing preexisting relationships between recipients and senders); **and**

Fergusson does not disclose **sending information to the recipient, said information indicating at least one of the following: the stored data indicating the last time that the incoming communication from the recipient is received, the type of the incoming communication from the recipient, and whether the time between the last time of the incoming**

communication and the present time does not exceed the predetermined time limit such that the recipient can confirm the preexisting business relationship between recipient and sender defined under the anti-spam, laws and regulations.

However, Griebenow discloses this (Column 8 lines 30 – 50 of Griebenow disclose determining whether it is time to send a renewal notice to the consumer because the consumer's subscriptions to the publication has lapsed or is about to lapse. Renewal notices will explicitly or implicitly (through the date of expiration) disclose the last time the consumer communicated with the service. Since the last time the consumer communicated is in the renewal notice it is seen that it has information indicating at least one of the above limitations)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of complying with a predetermined time limit as disclosed by Fergusson with informing the consumer of their last time of communication as disclosed by Griebenow. One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to prevent the relationship between the business and the consumer from ending. Griebenow explains in column 8 lines 30 – 50 that renewals are sent if a consumers subscription is about to lapse, this is done to prevent the termination of the subscription. Similarly, contact would be made to the consumer in Fergusson's invention to encourage a response such that future communications would remain DNC complaint, and thus prevent the termination of their business relationship.

17. **As to Claim 2**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 1, **wherein the incoming communication is received via one or more of the**

following: a direct communication, a postal mail, a data communication network, or a telephonic communication network (Paragraphs [0011] – [0015] of Fergusson disclose telemarketing which implies telephonic communications, mailing to home addresses which is postal mail, and e-mailing which is seen as data communication).

18. **As to Claim 4**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 1, **wherein said sending comprises sending the communication to the recipient if the stored data indicates that the present time is within a range prior to expiration of the predetermined time limit, said communication for inducing said recipient to send another incoming communication to the sender** (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

19. **As to Claim 5**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 1, **wherein if the time between the last time that the incoming communication is received and the present time exceeds the predetermined time limit, the communication is sent to the recipient via a channel permitted by a rule, law, or regulation that prescribes the predetermined time limit** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients

on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

20. **As to Claim 6**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 1, **further comprising:**

storing a list of recipients whose last time of incoming communications to the sender cannot be identified (Paragraph [0090] of Fergusson discloses a “On DNC List Without Prior Or Existing Relationship” list, this is read to be the list of people who do not have a prior relationship with the company and thus their last time of communication cannot be identified);
and

wherein said sending the communication comprises sending the communication to the recipient if the recipient is included in said list of recipients, said communication for inducing the recipient to send another incoming communication to the sender (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

21. **As to Claim 7**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 6, **further comprising removing the recipient from said list of recipients after the recipient has sent another incoming communication to the sender** (Paragraph [0084] of Fergusson discloses a “On DNC List But With Prior Or Existing Relationship” list, a “On DNC List Without Prior Or Existing Relationship” list, and a “Free to Call” list. The existence of each of these lists implies that clients whose calling status changes will be moved to an appropriate list. As such in the situation where a client on the DNC list was contacted and business was transacted it is likely the case that the client would then be moved to a more appropriate list reflecting the new relationship).

22. **As to Claim 8**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 1, **further comprising:**
storing a list of recipients who are included in a do-not-send list (Paragraph [0090] of Fergusson discloses a “On DNC List Without Prior Or Existing Relationship” list where the names of prospective clients who fall under that category reside);
identifying if the recipient is included in said list of recipients (Paragraphs [0091] – [0094] of Fergusson disclose a representative contacting a client through channels other than the telephone in order comply with DNC laws. This action would inherently include identifying if their intended client is on the DNC list otherwise such an action to comply with the DNC laws would not be taken); **and**
wherein said sending the communication comprises sending the communication to the recipient via a permitted channel if the recipient is included in said list of recipients

(Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

23. **As to Claim 9**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 8, **wherein said sending further comprises sending the communication to the recipient via any channel if the recipient is included in said list of recipients and the time between the last time that the incoming communication is received and the present time does not exceed the predetermined time limit** (Paragraphs [0011] – [0012] of Fergusson disclose that if an existing relationship exists between the company and client (read to be the same as not exceeding the time limit as explained in paragraph [0012]) the telemarketer is free to contact the identified DNC client despite being on the DNC list).

24. **As to Claim 10**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 1, **wherein the sender is a group** (Paragraph [0022] of Tucciarone discloses the system matches the requests of users (clients) with information inventory of multiple suppliers (read to be a group of senders)), **wherein said incoming communication from the recipient is received by one of the group** (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving

a request (incoming communication) from a person (recipient of communication)), **wherein said storing comprises storing data indicating the last time that the incoming communication is received by said one of the group** (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database), **and wherein said sending comprises sending the communication from said one of the group to the recipient if the time between the last time that the incoming communication is received by said one of the group and the present time does not exceed the predetermined time limit** (Paragraphs [0011] – [0013] of Fergusson disclose that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of claim 1 as disclosed by Fergusson-Tucciarone-Griebenow, with making the sender a group as disclosed by Tucciarone. One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to (paragraphs [0014] – [0020] of Tucciarone) give clients easier access to more information and so allow for a simple and easy way to receive services from multiple suppliers.

25. **As to Claim 11**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 1, **wherein one or more computer storage media have computer-**

executable instructions for performing the method recited in claim 1, further comprising executing said computer-executable instruction to implement said receiving, said identifying, said storing, said sending the communication and said sending information (Paragraph [0048] of Fergusson discloses a DNC handler block that performs processing to determine which DNC clients can be contacted and still maintain DNC compliance. This block implies the existence of computer instructions to make the block functional and thus reads upon the applicant's invention).

26. **As to Claim 24, Fergusson discloses a system for a sender of communications to comply with a predetermined time limit, comprising:**
a memory area adapted to store data indicating a last time that an incoming communication from a recipient is received by the sender, said stored data of the incoming communication indicating a location of the recipient based on the received incoming communication, said received incoming communication including at least one of the following types: an electronic mail (e-mail) message, a post mail, an instant messaging message, a chat message, and a website access (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database. Also the database itself serves as the memory area mentioned in the claim. As to the data also including the location of the recipient, paragraph [0016] of Fergusson discloses a new account worksheet for keeping information such

as the state of residence of the client. Then goes to say the information on the worksheet will be stored for at least the time period prescribed by appropriate DNC laws); **and**

However Fergusson did not explicitly disclose receiving an incoming communication, Tucciarone discloses this (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication). It is seen that the incoming communication includes at least an e-mail message and a website access based on figure 4 and paragraph [0012] of Tucciarone).

Examiner recites the same rationale to combine used in claim 1.

a device adapted to send a communication to the recipient if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed the predetermined time limit, said predetermined time limit being defined and prescribed by anti-spam rules, laws and regulations of the identified location of the recipient for establishing a preexisting relation between the recipient and the sender (Paragraph [0015] of Fergusson discloses the system may help generate a mailing or e-mail that can be send to the prospective client. Then in paragraphs [0011] – [0013] it is disclosed that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit). As to the time limit being defined by rules of the location, paragraph [0013] of Fergusson

discloses because the definition of when a prior or existing relationship exists may differ depending on the state, different parameter values may be set for each of the state DNC listings. Thus it is seen that since the time parameter is changed from state to state, that the time parameter is defined according to each individuals states DNC laws, which are for establishing preexisting relationships between recipients and senders); and

Fergusson does not disclose **wherein the device sends information to the recipient, said information indicating at least one of the following: the stored data indicating the last time that the incoming communication from the recipient is received , the type of the incoming communication from the recipient, and whether the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit such that the recipient can confirm the preexisting business relationship between recipient and sender defined under the anti-spam, laws and regulations.**

However, Griebenow discloses this (Column 8 lines 30 – 50 of Griebenow disclose determining whether it is time to send a renewal notice to the consumer because the consumer's subscriptions to the publication has lapsed or is about to lapse. Renewal notices will explicitly or implicitly (through the date of expiration) disclose the last time the consumer communicated with the service. Since the last time the consumer communicated is in the renewal notice it is seen that it has information indicating at least one of the above limitations)

Examiner recites the same rationale to combine used in claim 1.

27. **As to Claim 25**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 24, **wherein said device is a telephonic device, a server, or a client**

(Paragraph [0015] of Fergusson discloses contacting clients at home via the phone which implies a telephonic device and also generating e-mails which implies a server/client type system).

28. **As to Claim 26**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 24, **wherein the device is adapted to send the communication to the recipient if the stored data indicates that the present time is within a range prior to expiration of the predetermined time limit, said communication for inducing said recipient to send another incoming communication to the sender** (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

29. **As to Claim 27**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 24, **wherein the memory area is adapted to store a list of recipients whose last time of incoming communications to the sender cannot be identified** (Paragraph [0090] of Fergusson discloses a “On DNC List Without Prior Or Existing Relationship.” This is read to be the list of people who do not have a prior relationship with the company and thus their last time of communication cannot be identified. Where the existence of this list implies a memory area to store it in), **wherein the device is adapted to send the communication to the recipient if the recipient is included in said list of recipients, said communication for inducing the**

recipient to send another incoming communication to the sender (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future), **and further comprising computer-executable instructions to remove the recipient from said list of recipients after the recipient has sent another incoming communication to the sender** (Paragraph [0084] of Fergusson discloses a “On DNC List But With Prior Or Existing Relationship” list, a “On DNC List Without Prior Or Existing Relationship” list, and a “Free to Call” list. The existence of each of these lists implies that clients whose calling status changes will be moved to an appropriate list. As such in the situation where a client on the DNC list was contacted and business was transacted it is likely the case that the client would then be moved to a more appropriate list reflecting the new relationship. In Figure 9 these lists are shown on a webpage, which implies a backend containing instructions to support the lists).

30. **As to Claim 28**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 24, **wherein the sender is a group** (Paragraph [0022] of Tucciarone discloses the system matches the requests of users (clients) with information inventory of multiple suppliers (read to be a group of senders)), **wherein the memory area is adapted to store data indicating the last time that the incoming communication from the recipient is received by one of the group** (Paragraph [0012] of Fergusson discloses mining databases to determine the

length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database. Also the database itself serves as the memory area mentioned in the claim), **and wherein the device is adapted to send the communication from said one of the group to the recipient if the time between the last time that the incoming communication is received by said one of the group and the present time does not exceed the predetermined time limit** (Paragraph [0015] of Fergusson discloses the system may help generate a mailing or e-mail that can be send to the prospective client. Then in paragraphs [0011] – [0013] it is disclosed that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit)).

Examiner recites the same rationale to combine used in claim 10.

31. **As to Claim 29**, Fergusson discloses **a system for a sender of communications to comply with a rule, law, or regulation, comprising:**
computer-executable instructions (Paragraph [0048] of Fergusson discloses a DNC handler block that performs processing to determine which DNC clients and be contacted and still maintain DNC compliance. This block implies the existence of computer instructions to make the block functional and thus reads upon the applicant's invention) **to identify a location of a recipient based on an incoming communication received from the recipient , said received incoming communication including at least one of the following types: an electronic mail (e-**

mail) message, a post mail, an instant messaging message, a chat message, and a website access (Paragraph [0015] of Fergusson discloses doing a reverse phone number lookup to find the home address of the DNC client and the abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication). It is seen that the incoming communication includes at least an e-mail message and a website access based on figure 4 and paragraph [0012] of Tucciarone);

Examiner recites the same rationale to combine used in claim 1.

a memory area adapted to store data indicating the identified location of the recipient (Paragraph [0016] of Fergusson discloses a new account worksheet for keeping information such as the state of residence of the client. Then goes to say the information on the worksheet will be stored for at least the time period prescribed by appropriate DNC laws. This implies the existence of a memory area to store the data else the data could not be stored);

computer-executable instructions to determine if a communication complies with a rule, law, or regulation of the identified location of the recipient (Paragraph [0048] of Fergusson discloses a DNC handler block that performs processing to determine which DNC clients and be contacted and still maintain DNC compliance (complying with DNC rules). This block implies the existence of computer instructions to make the block functional and thus reads upon the applicant's invention), **said communication indicating if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed a predetermined time limit, said predetermined time limit**

being defined and prescribed by anti-spam rules, laws and regulations of the identified location of the recipient for establishing a preexisting relation between the recipient and the sender (Paragraph [0088] of Fergusson discloses that some clients listed on an “On DNC List But With Prior Or Existing Relationship” list can be contacted and others cannot. It then cites an example of one client being in Minnesota and able to be contacted and another client in Indiana who cannot be contacted despite both of them being on the list. This is explained to be because the definition of a relationship is different for each state. Given this example and the listing to support it, it is implied that Fergusson’s invention would check to see if a call would comply with rules of the clients location. As to the rule being determined by the location, it is seen above that there are different scenarios for Indiana and Minnesota. Then as to it being a pre-determined time limit paragraph [0013] of Fergusson discloses a prior relationship may be determined by if a client transacted business with the organization within the past year. Where the past year is further explained to be definable based on the different states DNC laws, which are for establishing preexisting relationships between recipients and senders); **and Fergusson does not disclose a first device adapted to send information to the recipient, said information indicating at least one of the following: the stored data indicating the last time that the incoming communication from the recipient is received, the type of the incoming communication from the recipient, and whether the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit such that the recipient can confirm the preexisting business relationship between recipient and sender defined under the anti-spam, laws and regulations**

However, Griebenow discloses this (Column 8 lines 30 – 50 of Griebenow disclose determining whether it is time to send a renewal notice to the consumer because the consumer's subscriptions to the publication has lapsed or is about to lapse. Renewal notices will explicitly or implicitly (through the date of expiration) disclose the last time the consumer communicated with the service. Since the last time the consumer communicated is in the renewal notice it is seen that it has information indicating at least one of the above limitations)

Examiner recites the same rationale to combine used in claim 1.

32. **As to Claim 30**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 29, **wherein said computer-executable instructions to determine if the communication complies with the rule, law or regulation comprises electronic mail client instructions** (Paragraph [0015] of Fergusson discloses that in one embodiment the system may generate an e-mail that can be sent to a client. Since the system that determines rule compliance also e-mails it can be viewed that an e-mail client is performing the rule compliance determination. Further since the system that does the determination of compliance was shown above to use computer instructions it is implied that the electronic mail client would also be supported similarly).

33. **As to Claim 31**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 29, **wherein the location of the recipient is identified based on a postal address if the postal address is provided with the incoming communication, wherein the location of the recipient is identified based on an internet protocol address, server location,**

or domain name of the recipient if the incoming communication is received via a data communication network, and wherein the location of the recipient is identified based on a telephonic address of the recipient if the incoming communication is received via a telephonic communication network (Paragraph [0091] of Fergusson discloses that in some cases limited information known about a client can be provided to one or more databases to return additional contact information. In one scenario the home address of the client is gotten by a reverse phone number lookup database. Similarly the other methods (mail/e-mail) could be handled by a similar method to find the location of the client).

34. **As to Claim 32**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 29, **wherein the first device is adapted to send the communication to the recipient via a channel permitted by the rule, law, or regulation of the identified location of the recipient if the communication is determined not to comply with the rule, law, or regulation** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

35. **As to Claim 33**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 32, **further comprising: computer-executable instructions to receive an input from the sender, said input indicating whether the communication complies with the**

rule, law, or regulation (Paragraph [0115] of Fergusson discloses a supervisor controls window that allows a compliance supervisor to set selected parameter values for states. For example the supervisor can set the level of what defines a states prior existing relationship. This is seen to be the same as the sender sending an input indicating compliance with rules. The control window mentioned is shown in Figure 13 to be a website, which implies a backend containing instructions to support control window); **and**

wherein the first device is adapted to send the communication to the recipient via any channel if the received input indicates that the communication complies with the rule, law, or regulation (Paragraphs [0011] – [0012] of Fergusson disclose that if an existing relationship exists between the company and client (read to be the same as not exceeding the time limit as explained in paragraph [0012]) the telemarketer is free to contact the identified DNC client despite being on the DNC list).

36. **As to Claim 36**, Fergusson discloses **one or more computer storage media having computer-executable components for a sender of communications to comply with a predetermined time limit, said computer-readable media comprising:**

Fergusson does not explicitly disclose **a receiving component for receiving an incoming communication from a recipient of communications, said received incoming communication including at least one of the following types: an electronic mail (e-mail) message, a post mail, an instant messaging message, a chat message, and a website access;**

However, Tucciarone discloses this (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This

is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication). It is seen that the incoming communication includes at least an e-mail message and a website access based on figure 4 and paragraph [0012] of Tucciarone)

Examiner recites the same rationale to combine used in claim 1.

Fergusson discloses **a storage component for storing data indicating a last time that the incoming communication is received by the sender, said stored data of the incoming communication indicating a location of the recipient based on the received incoming communication** (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database. Also the database itself serves as the memory area mentioned in the claim. As to the data also including the location of the recipient, paragraph [0016] of Fergusson discloses a new account worksheet for keeping information such as the state of residence of the client. Then goes to say the information on the worksheet will be stored for at least the time period prescribed by appropriate DNC laws); **and**
a sending component for sending a communication to the recipient if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed the predetermined time limit, said predetermined time limiting being defined and prescribed by anti-spam rules, laws and regulations of the identified location of the recipient for establishing a preexisting relation between the recipient and the sender (Paragraph [0015] of Fergusson discloses the system may

help generate a mailing or e-mail that can be send to the prospective client. Then in paragraphs [0011] – [0013] it is disclosed that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit). As to the time limit being defined by rules of the location, paragraph [0013] of Fergusson discloses because the definition of when a prior or existing relationship exists may differ depending on the state, different parameter values may be set for each of the state DNC listings. Thus it is seen that since the time parameter is changed from state to state, that the time parameter is defined according to each individuals states DNC laws, which are for establishing preexisting relationships between recipients and senders); and

Fergusson does not disclose wherein the sending component sends information to the recipient, said information indicating at least one of the following: the stored data indicating the last time that the incoming communication form the recipient is received, the type of the incoming communication from the recipient, and whether the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit such that the recipient can confirm the preexisting business relationship between recipient and sender defined under the anti-spam, laws and regulations.

However, Griebenow discloses this (Column 8 lines 30 – 50 of Griebenow disclose determining whether it is time to send a renewal notice to the consumer because the consumer's subscriptions to the publication has lapsed or is about to lapse. Renewal notices will explicitly or

implicitly (through the date of expiration) disclose the last time the consumer communicated with the service. Since the last time the consumer communicated is in the renewal notice it is seen that it has information indicating at least one of the above limitations)

Examiner recites the same rationale to combine used in claim 1.

37. **As to Claim 37**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 36, **wherein the sending component sends the communication to the recipient if the stored data indicates that the present time is within a range prior to expiration of the predetermined time limit, said communication for inducing said recipient to send another incoming communication to the sender** (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

38. **As to Claim 38**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 36, **wherein the storage component stores a list of recipients whose last time of incoming communications to the sender cannot be identified** (Paragraph [0090] of Fergusson discloses a “On DNC List Without Prior Or Existing Relationship” list This is read to be the list of people who do not have a prior relationship with the company and thus their last time of communication cannot be identified), **and wherein the sending component sends the**

communication to the recipient if the recipient is included in said list of recipients, said communication for inducing the recipient to send another incoming communication to the sender (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

39. **As to Claim 39**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 36, **wherein the storage component stores a list of recipients who are included in a do-not-send list** (Paragraph [0090] of Fergusson discloses a “On DNC List Without Prior Or Existing Relationship” list where the names of prospective clients who fall under that category reside), **and wherein the sending component sends the communication to the recipient via a permitted channel if the recipient is included in said list of recipients** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

40. **As to Claim 40**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 36. Fergusson-Tucciarone-Griebenow do not explicitly disclose **wherein the sender is a group** (Paragraph [0022] of Tucciarone discloses the system matches the requests of users (clients) with information inventory of multiple suppliers (read to be a group of senders)), **wherein said incoming communication from the recipient is received by one of the group** (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication)). Fergusson discloses **wherein the storage component stores data indicating the last time that the incoming communication is received by said one of the group** (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database), **and wherein the sending component sends the communication from said one of the group to the recipient if the time between the last time that the incoming communication is received by said one of the group and the present time does not exceed the predetermined time limit** (Paragraphs [0011] – [0013] of Fergusson disclose that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit)).

Examiner recites the same rationale to combine used in claim 10.

41. Claims 12-17, 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson-Tucciarone-Griebenow and further in view of U.S. Pub. No. 2004/0128321 A1 to Hamer (hereinafter “Hamer”).

42. **As to Claim 12**, Fergusson discloses **a method for a sender of communications to comply with a rule, law, or regulation, comprising:**
Fergusson does not explicitly disclose **receiving an incoming communication from a recipient of communications , said received incoming communication including at least one of the following types: an electronic mail (e-mail) message, a post mail, an instant messaging message, a chat message, and a website access;**

However, Tucciarone discloses this (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication). It is seen that the incoming communication includes at least an e-mail message and a website access based on figure 4 and paragraph [0012] of Tucciarone).

Examiner recites the same rationale to combine used in claim 1.

Fergusson discloses **identifying a location of the recipient based on the received incoming communication** (Paragraph [0015] of Fergusson discloses doing a reverse phone number lookup to find the home address of the DNC client);

storing data indicating the identified location of the recipient (Paragraph [0016] of Fergusson discloses a new account worksheet for keeping information such as the state of residence of the client. Then goes to say the information on the worksheet will be stored for at least the time period prescribed by appropriate DNC laws);

determining if a communication complies with a rule, law, or regulation of the identified location of the recipient, said communication indicating if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed a predetermined time limit, said time limit being defined and prescribed by anti-spam rules, laws and regulations of the identified location of the recipient for establishing a preexisting relation between the recipient and the sender

(Paragraph [0088] of Fergusson discloses that some clients listed on an “On DNC List But With Prior Or Existing Relationship” list can be contacted and others cannot. It then cites an example of one client being in Minnesota and able to be contacted and another client in Indiana who cannot be contacted despite both of them being on the list. This is explained to be because the definition of a relationship is different for each state. Given this example and the listing to support it, it is implied that Fergusson’s invention would check to see if a call would comply with rules of the clients location. As to the rule being determined by the location, it is seen above that there are different scenarios for Indiana and Minnesota. Then as to it being a pre-determined time limit paragraph [0013] of Fergusson discloses a prior relationship may be determined by if a client transacted business with the organization within the past year. Where the past year is further explained to be definable based on the different states DNC laws, which are for establishing preexisting relationships between recipients and senders);

Fergusson does not disclose **sending information to the recipient, said information indicating at least one of the following: the stored data indicating the last time that the incoming communication from the recipient is received , the type of the incoming communication from the recipient, and whether the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit such that the recipient can confirm the preexisting business relationship between recipient and sender defined under the anti-spam, laws and regulations; and**

However, Griebenow discloses this (Column 8 lines 30 – 50 of Griebenow disclose determining whether it is time to send a renewal notice to the consumer because the consumer's subscriptions to the publication has lapsed or is about to lapse. Renewal notices will explicitly or implicitly (through the date of expiration) disclose the last time the consumer communicated with the service. Since the last time the consumer communicated is in the renewal notice it is seen that it has information indicating at least one of the above limitations)

Examiner recites the same rationale to combine used in claim 1.

sending the communication to the recipient if the communication is determined to comply with the rule, law, or regulation of the identified location of the recipient (Paragraph [0088] of Fergusson discloses being able to contact a client who is in Minnesota because their prior relationship complies with DNC laws based on Minnesota's definition of prior relationship. Thus it is seen that after determining if the telemarketer's communication complies with DNC laws the telemarketer will contact the client). Fergusson does not disclose **wherein if multiple locations of the recipient are identified, the location of the recipient is the location having the most restrictive rule, law or regulation among the identified multiple locations.**

However, Hamer discloses this (Paragraphs [0056] – [0059] of Hamer disclose a rule engine that selects which rules to follow based on specific criteria. It further explains that in the case where more than one rule set is applicable the engine locates the primary rule set by finding the highest-ranking rule set with the most restrictive action value. In Fergusson it was disclosed that a supervisor could set the various rules associated with the different states (seen to be the same as having more than one applicable rule set). Thus when the rule engine is combined with the rule sets of the various states it can be seen that the same idea is disclosed. Namely Hamer discloses both the idea of having multiple locations associated with one recipient (having more than one rule set applicable) as well as selecting the most restrictive action (finding the highest-ranking rule set).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of verifying DNC compliance as disclosed by Fergusson, with the rule engine as disclosed by Hamer. One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to comply with DNC laws. As disclosed by Fergusson the entire invention pertains to preventing a company from unintentionally breaking laws dealing with DNC lists. As such it would be obvious in the scenario where a client is potentially affected by two laws to choose the more restrictive one. For if the company complies with the more restrictive rule set there is no way the company can accidentally break the law in either state. If, however, the company chose the more lenient rule set there would be the potential for breaking the law in the other state. Thus it would be obvious to implement the rule engine feature in the scenario where a client is based in more than one state.

43. **As to Claim 13**, Fergusson-Tucciarone-Griebenow-Hamer discloses the invention as claimed as described in claim 12, **wherein said determining if the communication complies with the rule, law, or regulation of the identified location of the recipient comprises determining if the communication complies with the rule, law, or regulation via textual analysis of the communication** (Paragraphs [0091] – [0093] of Fergusson disclose an embodiment where the communication can be done via e-mail or mail instead. In these situations because they are inherently text it would be obvious that any analysis done on them would be textual analysis. Thus it is seen that determination of compliance for this embodiment would inherently use textual analysis).

44. **As to Claim 14**, Fergusson-Tucciarone-Griebenow-Hamer discloses the invention as claimed as described in claim 12, **wherein said determining if the communication complies with the rule, law, or regulation is performed in an electronic mail client** (Paragraph [0015] of Fergusson discloses that in one embodiment the system may generate an e-mail that can be sent to a client. Since the system that determines rule compliance also e-mails it can be viewed that an e-mail client is performing the rule compliance determination).

45. **As to Claim 15**, Fergusson-Tucciarone-Griebenow-Hamer discloses the invention as claimed as described in claim 12, **wherein said sending the communication comprises sending the communication to the recipient via a channel permitted by the rule, law, or regulation of the identified location of the recipient if the communication is determined not**

to comply with the rule, law, or regulation (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

46. **As to Claim 16**, Fergusson-Tucciarone-Griebenow-Hamer discloses the invention as claimed as described in claim 15, **further comprising:**

receiving an input from the sender, said input indicating whether the communication complies with the rule, law, or regulation (Paragraph [0115] of Fergusson discloses a supervisor controls window that allows a compliance supervisor to set selected parameter values for states. For example the supervisor can set the level of what defines a states prior existing relationship. This is seen to be the same as the sender sending an input indicating compliance with rules); **and**

wherein said sending the communication comprises sending the communication to the recipient via any channel if the received input indicates that the communication complies with the rule, law, or regulation (Paragraphs [0011] – [0012] of Fergusson disclose that if an existing relationship exists between the company and client (read to be the same as not exceeding the time limit as explained in paragraph [0012]) the telemarketer is free to contact the identified DNC client despite being on the DNC list).

47. **As to Claim 17**, Fergusson-Tucciarone-Griebenow-Hamer discloses the invention as claimed as described in claim 12, **wherein the location of the recipient is identified based on a postal address if the postal address is provided with the incoming communication, wherein the location of the recipient is identified based on an internet protocol address, server location, or domain name of the recipient if the incoming communication is received via a data communication network, and wherein the location of the recipient is identified based on a telephonic address of the recipient if the incoming communication is received via a telephonic communication network** (Paragraph [0091] of Fergusson discloses that in some cases limited information known about a client can be provided to one or more databases to return additional contact information. In one scenario the home address of the client is gotten by a reverse phone number lookup database. Similarly the other methods (mail/e-mail) could be handled by a similar method to find the location of the client).

48. **As to Claim 19**, Fergusson-Tucciarone-Griebenow-Hamer discloses the invention as claimed as described in claim 12, **wherein the location of the recipient is a location having the most restrictive rule, law, or regulation if the location of the recipient cannot be identified** (Paragraphs [0056] – [0059] of Hamer disclose a rule engine that selects which rules to follow based on specific criteria. It further explains that in the case where more than one rule set is applicable the engine locates the primary rule set by finding the highest-ranking rule set with the most restrictive action value. In Fergusson it was disclosed that a supervisor could set the various rules associated with the different states (seen to be the same as having more than one applicable rule set). Thus when the rule engine is combined with the rule sets of the various

states it can be seen that the same idea is disclosed. Namely Hamer discloses both the idea of having multiple locations associated with one recipient (having more than one rule set applicable) as well as selecting the most restrictive action (finding the highest-ranking rule set).

Examiner recites the same rationale to combine used in claim 12.

49. **As to Claim 23**, Fergusson-Tucciarone-Griebenow-Hamer discloses the invention as claimed as described in claim 12, **wherein one or more computer storage media have computer-executable instructions for performing the method recited in claim 12, , further comprising executing said computer-executable instruction to implement said receiving, said identifying, said storing, said sending the communication and said sending information** (Paragraph [0048] of Fergusson discloses a DNC handler block that performs processing to determine which DNC clients and be contacted and still maintain DNC compliance. This block implies the existence of computer instructions to make the block functional and thus reads upon the applicant's invention).

50. Claims 20, 21 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson-Tucciarone-Griebenow-Hamer and further in view of U.S. Pub. No. 2004/0017899 A1 to Garfinkel et al. (hereinafter "Garfinkel").

51. **As to Claim 20**, Fergusson-Tucciarone-Griebenow-Hamer discloses the invention as claimed as described in claim 12. Fergusson-Tucciarone-Griebenow-Hamer does not explicitly disclose **wherein said sending the communication to the recipient comprises: effecting**

compliance of the communication with the rule, law, or regulation of the identified location of the recipient if the communication is determined not to comply with the rule, law, or regulation; and sending the compliant communication to the recipient.

However, Garfinkel discloses this (Abstract of Garfinkel discloses determining if a call requires caller ID information and then if it is determined that caller ID information is required the system will provide a predetermined called ID information packet with the call. Otherwise if the call is determined to not require caller ID information the system will allow the call to continue freely. Then as to sending the complaint communication, paragraph [0011] of Garfinkel discloses then routing the call to its final destination)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of claim 12 as disclosed by Fergusson-Tucciarone-Griebenow-Hamer, with effecting compliance on a communication as disclosed by Garfinkel. One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to (paragraph [0003] of Garfinkel) assure compliance with Federal and State Caller ID transmission rules. In the case of e-mail it would be similarly beneficial to add compliance to adhere to DNC rules.

52. **As to Claim 21**, Fergusson-Tucciarone-Griebenow-Hamer-Garfinkel discloses the invention as claimed as described in claim 20, **wherein said effecting compliance of the communication comprises including one or more of the following information in the communication if required by the rule, law, or regulation of the identified location of the recipient: a labeling that the communication is unsolicited, an address of the sender, a**

phone number of the sender, or unsubscription information (Abstract of Garfinkel discloses determining if a call requires caller ID information and then if it is determined that caller ID information is required the system will provide a predetermined called ID information packet with the call. Otherwise if the call is determined to not require caller ID information the system will allow the call to continue freely).

Examiner recites the same rationale to combine used in claim 20.

53. **As to Claim 34**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 29. Fergusson-Tucciarone-Griebenow does not explicitly disclose **further comprising computer-executable instructions to effect compliance of the communication with the rule, law, or regulation of the identified location of the recipient if the communication is determined not to comply with the rule, law, or regulation, and wherein the first device is adapted to send the compliant communication to the recipient.**

However, Garfinkel discloses this (Abstract of Garfinkel discloses determining if a call requires caller ID information and then if it is determined that caller ID information is required the system will provide a predetermined called ID information packet with the call. Otherwise if the call is determined to not require caller ID information the system will allow the call to continue freely. Then as to sending the complaint communication, paragraph [0011] of Garfinkel discloses then routing the call to its final destination)

Examiner recites the same rationale to combine used in claim 20.

54. Claims 22 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson-Tucciarone-Griebenow-Hamer and further in view of U.S. Pat. No. 7155608 B1 to Malik et al. (hereinafter "Malik").

55. **As to Claim 22**, Fergusson-Tucciarone-Griebenow-Hamer discloses the invention as claimed as described in claim 12. Fergusson-Tucciarone-Griebenow-Hamer does not explicitly disclose **further comprising using a first computer having a first internet protocol address or domain to send the communication to the recipient if the communication is determined to comply with the rule, law, or regulation of the identified location of the recipient and using a second computer having a second internet protocol address or domain different from the first internet protocol address or domain to send the communication to the recipient if the communication is determined not to comply with the rule, law, or regulation of the identified location of the recipient.**

However, Malik discloses this (Column 1 lines 30 – 67 and Column 2 lines 1 – 30 of Malik disclose that a current method employed by spammers is to use a different IP address in case their current one gets blocked. This is seen to be implementing the same idea as the applicant's invention. The first computer exists to take care of compliant e-mail and the second computer exists to send out e-mail that is not compliant. Similarly Malik describes a system where a spammer will mail out from one IP until that IP is blocked and then begin to mail from another IP. The essential thing being that when the circumstances change, they both change IP's to circumvent the current problem).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of claim 12 as taught by Fergusson-Tucciarone-Griebenow-Hamer, with changing IP addresses to bypass the situation as taught by Malik. One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to further extend the idea of circumventing the DNC laws. Fergusson teaches using other methods such as e-mail or snail mail to circumvent not being able to call the DNC numbers. Had a rule existed such that the telemarketer could simply use a different phone line and still be within DNC compliance it would have been obvious to add such a feature to the invention disclosed in Fergusson.

56. **As to Claim 35**, Fergusson-Tucciarone-Griebenow discloses the invention as claimed as described in claim 29. Fergusson-Tucciarone-Griebenow does not explicitly disclose **further comprising: a second device having a second internet protocol address or domain and adapted to send the communication to the recipient if the communication is determined not to comply with the rule, law, or regulation of the identified location of the recipient; and wherein the first device has a first internet protocol address or domain different from the second internet protocol address or domain and is adapted to send the communication to the recipient if the communication is determined to comply with the rule, law, or regulation of the identified location of the recipient.**

However, Malik discloses this (Column 1 lines 30 – 67 and Column 2 lines 1 – 30 of Malik disclose that a current method employed by spammers is to use a different IP address in case their current one gets blocked. This is seen to be implementing the same idea as the

applicant's invention. The first computer exists to take care of compliant e-mail and the second computer exists to send out e-mail that is not compliant. Similarly Malik describes a system where a spammer will mail out from one IP until that IP is blocked and then begin to mail from another IP. The essential thing being that when the circumstances change they both change IP's to circumvent the current problem)

Examiner recites the same rationale to combine used in claim 22.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN S. MAI whose telephone number is (571)270-5001. The examiner can normally be reached on Monday through Friday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KSM

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